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10/649,048

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EXAMINER

KHAN, ASHER R

ART UNIT

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4134

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/649,048 | <b>Applicant(s)</b><br>AKUTSU ET AL. |  |
|                              | <b>Examiner</b><br>ASHER KHAN        | <b>Art Unit</b><br>4134              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 5 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/26/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/26/2003</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: Summary of invention contains a word "elongated" instead of decode on page 6. Appropriate correction is required.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: Claim 1 contains the misspelled word "imige". Appropriate correction is required.

3. Claims 5 and 11 are objected to because of following informalities: Claim 5 and 11 contain word "elongated" instead of "decoded". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 1, 7-8 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Pub. 2003/0112345 A1 *Yamaguchi et al.* ("*Yamaguchi*").

As to claim 1, *Yamaguchi* discloses an image data recording apparatus (0012) comprising:

image signal processing means for converting an image signal to a digital image signal (0055, Fig. 2, A/D 33);

first image compressing means for encoding said digital image signal to first image data according to first recording format (0075);

second image compressing means for encoding said digital image signal to second image data according to second recording format whose coding rate is lower than the coding rate of the first recording format (0015)(0016) (0074);

recording means for recording image data on a recording medium ( Fig. 2; CPU 22);

transmission means for transmitting image data to an external apparatus (0054); and

control means for providing control so that said digital image signal is encoded to said second image and recorded on said recording medium (0074), and after connection is established with the external apparatus, said digital image signal is encoded to said first image data and transmitted to the external apparatus via the transmission means (0075).

As to claim 7, *Yamaguchi* discloses an image data recording method (0012) comprising the steps of:

establishing connection with an external apparatus (0054);

converting an image signal to a digital image signal (0055, Fig. 2, A/D 33);

encoding said digital image signal to first image data according to first recording format (0075);

encoding said digital image signal to second image data according to second recording format whose coding rate is lower than the coding rate of the first recording format (0015)(0016)(0074);

recording said second image data on a recording medium (Fig. 2; CPU 22); and

transmitting said first image data to said external apparatus(0054).

As to claim 8, *Yamaguchi* further discloses wherein said first image data is recorded on said recording medium and then transmitted to the external apparatus and the recorded first image data is erased from said recording medium after the transmission is complete (0075).

As to claim 13, *Yamaguchi* discloses an information recording method (0012) comprising the steps of:

establishing connection with an external apparatus (0054);

converting an information signal to a digital information signal (0055, Fig. 2, A/D 33);

encoding said digital information signal to first information data according to first recording format (0075);

encoding said digital information signal to second information data according to second recording format whose coding rate is lower than the coding rate of the first recording format; recording said second information data on a recording medium (0015)(0016) (0074);and

transmitting said first information data to said external apparatus (0054).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0112345 A1 *Yamaguchi et al.* ("*Yamaguchi*") in view of U.S. Patent Pub. US 2002/0126999 A1 *Shimamoto et al.* ("*Shimamoto*").

As to claim 2, *Yamaguchi* discloses after said first image data is recorded on said recording medium and then transmitted via said transmission means to the external apparatus (0057).

*Yamaguchi* does not expressly disclose wherein said control means provides further control so that if said recording medium has not a sufficient recording capacity, the recorded first image data is erased from said recording medium.

*Shimamoto* discloses wherein said control means provides further control so that if said recording medium has not a sufficient recording capacity, the recorded first image data is erased from said recording medium (0109).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine *Yamaguchi* with *Shimamoto*. The Motivation to combine the two references would have been to erase previously recorded program to secure free space on a recording medium, to obtain sufficient recording area (*Shimamoto*, 0109)

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of *Yamaguchi* and *Shimamoto* to obtain the invention as specified in claim 2.

8. Claim 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0112345 A1 *Yamaguchi et al.* ("*Yamaguchi*") in view of U.S. Patent Pub. 2002/0003578 A1 *Koshiba et al.* ("*Koshiba*")

As to claim 3, *Yamaguchi* discloses display means (Fig. 2, LCD 43) for displaying images, and image decoding means for decoding said second image data to an image signal which can be represented on said display means (Fig 2, CPU 22),

*Yamaguchi* does not expressly disclose wherein said control means provides further control so that if an operation is made to instruct replay, said second image data recorded on said recording medium is decoded by said image decoding means and images are displayed on said display means based on the decoded second image data.

*Koshiba* disclose wherein said control means provides further control so that if an operation is made to instruct replay, said second image data recorded on said recording medium is decoded by said image decoding means and images are displayed on said display means based on the decoded second image data (0099).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine *Yamaguchi* with *Koshiba*. The Motivation to combine the two references would have been to view the captured images on the screen (*Koshiba*, 0099).

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of *Yamaguchi* and *Koshiba* to obtain the invention as specified in claim 3.

As to claim 9, *Koshiba* further discloses wherein if an operation is made to instruct replay, second image data recorded on said recording medium is decoded and

images are displayed on display means based on the decoded second image data (0099).  
In addition, the same motivation is used as the rejection for claim 3.

9. Claim 4, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0112345 A1 *Yamaguchi et al.* ("*Yamaguchi*") in view of U.S. Patent No 4,488,433 *Washino et al.* ("*Washino*") in view of U.S. Patent Pub. 2002/0003578 A1 *Koshiba et al.* ("*Koshiba*").

As to claim 4, *Yamguchi* discloses an image data recording and reproducing apparatus (0012) comprising:

Image signal processing means for converting an image signal to a digital image signal (0055, Fig. 2, A/D 33);

first image encoding means for encoding said digital image signal to first image data according to first recording format (0075);

second image encoding means for encoding said digital image signal to second image data according to second recording format whose coding rate is lower than the coding rate of the first recording format (0015)(0016)(0074);

a display means for displaying images (Fig 2, LCD 43);

image decoding means for decoding said second image data to an image signal which can be represented on said display means (Fig 2, CPU 22); and

*Yamaguchi* does not expressly disclose control means for providing control so that said second image data recorded on said recording medium is decoded by said image decoding means and images are displayed on said display means based on the decoded second image data.



*Koshiba* discloses disclose control means for providing control so that said second image data recorded on said recording medium is decoded by said image decoding means and images are displayed on said display means based on the decoded second image data (0099).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine *Yamaguchi* with *Koshiba*. The Motivation to combine the references would have been to view the captured imaged on the screen.

*Yamaguchi* in view of *Koshiba* does not expressly disclose a first drive for recording and reproducing said first image data on and from an interchangeable first recording medium;

a second drive for recording and reproducing said second image data on and from a second recording medium therein;

*Washino* discloses a first drive for recording and reproducing said first image data on and from an interchangeable first recording medium (Col. 3, lines 33-40);

a second drive for recording and reproducing said second image data on and from a second recording medium therein (*Washino*, col. 3, lines 41-48);

At the time of invention, it would have been obvious to the person of ordinary skill in the art to combine *Washino*, *Koshiba* and *Yamaguchi*. Motivation to combine the *Yamaguchi*, *Koshiba* and *Washino* would have been to have removable media (*Washino*, Abstract) for portability and be able to play the media on different devices other than the recording device. Also having a removable media allows you to have a longer recording time by interchanging the recorded media with new media for recording.

As to claim 6, *Koshiba* discloses wherein said control means provides further control so that if an operation is made to instruct replay image data and the requested image data can be replayed from said first drive, the corresponding first image data recorded on said first recording medium is decoded by said image decoding means and images are displayed on said display means based on the decoded first image data (0099). In addition, the same motivation is used as the rejection for claim 3.

As to claim 12, *Koshiba* discloses wherein if it is requested to replay image data and the requested image data can be replayed based on the corresponding first image data, that first image data recorded on said first recording medium is decoded and images are displayed on said display means based on the decoded first image data (0099). In addition, the same motivation is used as the rejection for claim 3.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of *Yamaguchi*, *Koshiba*, and *Washino* to obtain the invention as specified in claims 4, 6, and 12.

8. Claim 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0112345 A1 *Yamaguchi et al.* ("*Yamaguchi*") in view of U.S. Patent No 4,488,433 *Washino et al.* ("*Washino*") in view of U.S. Patent Pub. 2002/0003578 A1 *Koshiba et al.* ("*Koshiba*") and in further view of U.S. Patent Pub. 2005/0022051 A1 *Zane et al.* ("*Zane*")

As to claim 5, *Koshiba* discloses the corresponding second image data recorded on said second recording medium is decoded by said image decoded means and images are displayed on said display means based on the decoded second image data (0099).

*Koshiba* does not expressly disclose wherein said control means provides further control so that if an operation is made to instruct replay image data but the requested image data cannot be replayed from said first drive.

*Zane* discloses wherein said control means provides further control so that if an operation is made to instruct replay image data but the requested image data cannot be replayed from said first drive (0065).

At the time of invention, it would have been obvious to the person of ordinary skill in the art to combine *Washino*, *Koshiba*, *Yamaguchi* and *Zane*. Motivation to combine would have been that if image is unavailable on one recording medium the image is accessed from a second recording medium (0027).

As to claim 11, *Koshiba* discloses the corresponding second image data recorded on said second recording medium is decoded and images based on the decoded second image data are displayed.

*Koshiba* does not expressly disclose wherein if it is requested to replay image data but the requested image data cannot be replayed based on the corresponding first image data.

*Zane* discloses wherein if it is requested to replay image data but the requested image data cannot be replayed based on the corresponding first image data (0065). In addition, the same motivation is used as the rejection for claim 5.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of *Yamaguchi*, *Koshiba*, *Zane* and *Washino* to obtain the invention as specified in claims 5 and 11.

10. Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0112345 A1 *Yamaguchi et al.* ("*Yamaguchi*") in view of U.S. Patent No 4,488,433 *Washino et al.* ("*Washino*")

As to claim 10, *Yamaguchi* discloses an image data recording and reproducing ((0012) method comprising the steps of:

converting an image signal to a digital image signal (0055, Fig. 2, A/D 33);

encoding said digital image signal to first image data according to first recording format (0075);

encoding said digital image signal to second image data according to second recording format whose coding rate is lower than the coding rate of the first recording format(0015)(0016)(0074);

decoding second image data recorded on said second recording medium (Fig. 2, CPU 22);

and displaying images on display means based on the decoded second image data (Fig. 2, LCD 43).

*Yamaguchi* does not expressly disclose recording said first image data on an interchangeable first recording medium;

recording said second image data on second recording medium;

*Washino* discloses recording said first image data on an interchangeable first recording medium(Col. 3, lines 33-40);

recording said second image data on second recording medium (*Washino*, col. 3, lines 41-48);

At the time of invention, it would have been obvious to the person of ordinary skill in the art to combine *Washino* with *Yamaguchi*. Motivation to combine the

*Yamaguchi* with *Washino* would have been to have removable media (Abstract) for portability and be able to play the media on different devices other than the recording device. Also having a removable media allows you to have a longer recording time by interchanging the recorded media with new media for recording.

As to claim 14, *Yamaguchi* discloses an information recording and reproducing method (0012) comprising the steps of:

converting an information signal to a digital information signal (0055, Fig. 2, A/D 33);

encoding said digital information signal to first information data according to first recording format (0075);

encoding said digital information signal to second information data according to second recording format whose coding rate is lower than the coding rate of the first recording format (0074);

displaying information on display means based on the decoded second information data (Fig. 2, CPU 22, LCD 43).

*Yamaguchi* does not expressly disclose recording said first information data on an interchangeable first recording medium;

recording said second information data on second recording medium;

decoding second information data recorded on said second recording medium;

*Washino* discloses recording said first information data on an interchangeable first recording medium (Col. 3, lines 33-40);

recording said second information data on second recording medium (*Washino*, col. 3, lines 41-48);

decoding second information data recorded (Fig 2, CPU 22) on said second recording medium (Fig. 2, digital tape drive 88);

At the time of invention, it would have been obvious to the person of ordinary skill in the art to combine *Washino* with *Yamaguchi*. Motivation to combine the *Yamaguchi* with *Washino* would have been to have removable media (*Washino*, Abstract) for portability and be able to play the media on different devices other than the recording device. Also having a removable media allows you to have a longer recording time by interchanging the recorded media with new media for recording.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of *Yamaguchi* and *Washino* to obtain the invention as specified in claims 10 and 14.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on Monday-Friday 9:30 am - 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derrick Ferris can be reached on (571)272-3123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4134

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. K./

Examiner, Art Unit 4134

/Derrick W Ferris/

Supervisory Patent Examiner, Art Unit 4134